



UNITED STATES DEPARTMENT OF COMMERCE
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| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
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| 2,192,400 | 12/01/94 | VEROLD | 4661-10-011 |

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12M1/9314

| EXAMINER | |
|----------|--------------|
| TAN, J | |
| ART UNIT | PAPER NUMBER |
| 1304 | 13 |

DATE MAILED:

03/14/95

Below is a communication from the EXAMINER in charge of this application
COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

- a) ☒ is extended to run _____ or continues to run three months from the date of the final rejection
- b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☐ Appellant's response to the final rejection, filed _____ has been considered with the following effect, but it is not deemed to place the application in condition for allowance:
1. ☐ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
 - b. ☐ They raise new issues that would require further consideration and/or search. (See Note).
 - c. ☐ They raise the issue of new matter. (See Note).
 - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
 - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE:

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: 18-20 29-31

Claims objected to: 3-7, 18-20

Claims rejected: 1, 2, 8-10, 12, 15, 32

However;

- ☐ Applicant's response has overcome the following rejection(s): _____
4. ☐ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because _____
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☒ Other

see attached office action

Art Unit: 1203

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. Note the terms "benzyloxy", "benzyl-s-" and any term containing them.

Claims 1-2 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

The rejection of claims 1,2,8-10,12,15,32 under 35 USC 112, first and second paragraphs is maintained for reasons of record.

1. The definition of esters and prodrugs are in the specification, thus the claims have the antecedent basis. But the claims are not-enabled since not a single example containing the recited ester group or the pro-drug thereof has been prepared, let alone any of them have been tested in vitro or in vivo.

2. The date of the reference for supporting the method claims is not good for overcoming the rejection.

Claims 3-7,18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

Claims 29-31 are allowable.

The change of inventorship has been noted and such change will be done. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANE FAN whose telephone number is (703) 308-4705.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

JTF MARCH 13, 1995


JANE FAN
PRIMARY EXAMINER
GROUP 1200